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Attorney Docket No. 05725.0623-00000

A circular black ink stamp from the Office of Intellectual Property (OIP). The text "OIP" is at the top, "JC10" is at the top right, "MAR 13 2002" is in the center, and "PATENT &amp; TRADEMARK OFFICE" is at the bottom.

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**RESPONSE AFTER FINAL UNDER 37 C.F.R. § 1.116**

## Status of Claims

Claims 23-62 are pending in the application. No claims have been amended in this Response and no new matter has been added.

## Rejections under 35 U.S.C. § 103

Claims 23-62 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Aaslyng et al. (WO 97/19998) in view of Audousset et al. (U.S. 5,769,903). Applicants'

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prior arguments were rejected by the Office "because the arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on a combination of references." Final Office Action at page 2. The Office proceeded to cite *In re Keller*, 642 F.2d 413 (C.C.P.A. 1981) and *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). Additionally, the Office asserted that "it is prima facie obvious to combine two compositions each of which is taught by [the] prior art to be useful for [the] same purpose in order to form [a] third composition that is to be used for [the] very same purpose," and cited *In re Kerkhoven*, 205 U.S.P.Q. 1069 (C.C.P.A. 1980) for support. Applicants respectfully disagree with the Office's position and traverses the rejections, for at least the reasons of record and as follows.

In citing *In re Keller*, the Office has misapplied the law. *In re Keller* states that "[t]he test for obviousness is not ... that the claimed invention must be expressly suggested in any one or all of the references." *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Applicants are not attacking the references individually. Rather, Applicants have questioned and continue to question the Examiner's basis for combining the references in the first place.

When an Examiner relies on a combination of references, he can satisfy the burden of obviousness "only by showing some objective teaching [*leading to the combination*]." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added). In the present case, the Examiner has not satisfied this burden, as argued previously on the record.

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Applicants also disagree with the Office's reliance on *Kerkhoven*. First, the facts and holding of *Kerkhoven* involved "combin[ing] two compositions each of which is taught by the prior art to be useful for the same purpose." *In re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980) (emphasis added). However, in contrast to *Kerkhoven*, in the present case the Office does not appear to be combining compositions. Rather, in an effort to reproduce Applicants' claimed invention, the Office is picking and choosing individual components from isolated disclosures in the cited references. However, "[s]uch piecemeal reconstruction of the prior art patents in light of [Applicant's] disclosure is contrary to the requirements of 35 U.S.C. 103." *In re Wesslan*, 147 USPQ 391, 393 (CCPA 1965).

In order to properly apply *Kerkhoven*, the combination from the two cited references would be: one or more oxidation enzymes, one or more dye precursors, and one or more modifiers (couplers) not including indoles, where the preceding are from *Aaslyng*; and then from *Audousset*, at least one oxidation base, at least one indole coupler, at least one heterocyclic coupler, and an acidifying or a basifying agent. This combination is not the composition claimed and therefore *Kerkhoven* is misapplied.

Further, if the Office is suggesting the combination of compositions, Applicants submit that the Office has no evidence from which it can predict the outcome of such a combination, or have a reasonable expectation of success for the combination. In fact, it is known that dye components can interact to affect the properties of the composition unpredictably, including its toxicity. For example, in C. Zviak, *The Science of Hair Care*, Marcel Kekker, Inc., p. 329 (1986), Zviak explains that, with respect to the safety of finished products, "[a]ll finished cosmetic products must be evaluated for safety in use to

make sure that they do not, under normal and foreseeable conditions, constitute a potential hazard for the consumer....” Zviak explains that such testing is not easily accomplished due to unpredictable component interactions. Specifically, “[i]t might seem that a sensible way of proceeding would be to conduct most toxicological tests on the ingredients, which would reduce the amount of experimentation and cost of developing finished products. However, experience has shown that the formulation itself is the important element. It determines local tolerance after a single or repeated application, eye and/ or lung mucosa tolerance, the degree of absorption through the skin, etc.” *Id.* Further, according to Zviak, synergistic effects that make a product more or less toxic may occur. That is, “[a]part from the effect of the vehicle, it has been observed that the association of different compounds can produce either synergistic toxicity or, on the contrary, a mitigation or even inhibition of toxic effects.” *Id.*

The Office’s conclusory statements are not adequate grounds for a rejection based on obviousness. “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998). Indeed, the Examiner can satisfy the burden of showing obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992).

In this case, the Office has not provided an adequate explanation of why it would have been allegedly obvious to combine the teachings of *Aaslyng* and *Audousset*.

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Here, *Aaslyng* fails to provide the requisite motivation necessary to support a prima facie case of obviousness because it does not teach or suggest the inclusion of any alkalizing agent, let alone the basifying agents taught in *Audousset*. Further, there would have been no reasonable expectation of success for such a combination because *Audousset* does not disclose the utility of basifying agents in combination with laccases, or any enzymes for that matter.

Reconsideration and withdrawal of the rejections are respectfully requested. Should the Office continue to dispute the patentability of the present claims, Applicants request the Examiner to contact the undersigned representative to schedule an in-person interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 13, 2002

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